



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,474	10/22/2001	Edwin Tam	051373-0113	9740

26371 7590 02/17/2006

FOLEY & LARDNER LLP
777 EAST WISCONSIN AVENUE
SUITE 3800
MILWAUKEE, WI 53202-5308

EXAMINER

NGUYEN, CAO H

ART UNIT PAPER NUMBER

2173

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,474

Applicant(s)

TAM, EDWIN

Examiner

Cao (Kevin) Nguyen

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is responsive to the Request for Continued Examination (RCE) filed under 37 CFR §1.53(d) for the instant application on 11/28/05. Applicants have properly set forth the RCE, which has been entered into the application, and an examination on the merits follows herewith.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jen et al. (US Patent Application Publication No. US 2002/0194297) in view of Gustafson et al. (US Patent Application Publication No. US 2002/0025085).

Regarding claims 1 and 10, Jen discloses a method of selecting and presenting user customizable preferences, the method comprising: providing a user interface display having a list of user preference selection fields including a customized selection field [..utilizing personal information to customize a user's experience when interacting with an application program; see

Art Unit: 2173

col. 2, lines 0025-0026]; receiving a selection of the customizable selection field [..the user interface presents the user with a window that includes one or more fields; see col. 4, lines 0041-0042]; and presenting the customized user preference value in the list of user preference selection fields along with the customizable selection field [..the user can be a user preferences window wherein each tab can include one or more fields; see col. 5, lines 0051-0052].

However, Jen fails to explicitly teach receiving a customized user preference value as an input to the customizable selection field.

Gustafson discloses receiving a customized user preference value as an input to the customizable selection field [..specifying values for the user can customize the item to their personal preference; see col. 2, lines 0031-0033]. It would have been obvious to one of an ordinary skill in the art, having the teachings of Jen and Gustafson before him at the time the invention was made, to modify a providing user interface display having a list of user preference selection fields including a customized selection field of Jen to include a customized user preference value, as taught by Gustafson. One would have been obvious to one of an motivated to make such a combination in order to allow users to select from pre-defined preferences as well as a personal customized preferences.

Regarding claims 2 and 11, Gustafson discloses, wherein the step of receiving a customized user preference value includes launching a data entry request window when the customizable selection field is selected [..a self-describing template, a user would input parameter of a desired item; see col. 9, lines 0097-0098].

Art Unit: 2173

Regarding claims 3 and 12, Jen discloses, wherein the step of receiving a customized user preference value includes accessing a stored value previously entered by a user (see col. 5, lines 0045-0047).

Regarding claim 4, Jen discloses, wherein the customizable selection is set to be the default selection field is set to be a default selection in the list of user preference selection fields such that the customizable selection field and customized user preference value are displayed in the list of user preference selection fields (see col. 5, lines 0049-0051).

Regarding claims 5 and 13, Jen discloses wherein the step of presenting the customized user preference value along with the customizable selection field in the list of user preference selection fields includes presenting the customized user preference value in parenthesis next to the customizable selection field in the list of user preference selection fields (see col. 5, lines 0051-0054).

Regarding claims 6 and 14, Gustafson discloses and wherein the customizable selection corresponds to a specific image compression percentage (see col. 9, lines 0101-0102). It would have been obvious to one of an ordinary skill in the art, having the teachings of Jen and Gustafson before him at the time the invention was made, to modify a providing user interface display having a list of user preference selection fields including a customized selection field of Jen to include a corresponds to a specific image compression percentage, as taught by Gustafson. One would have been obvious to one of an motivated to make such a combination in order to allow users to select from pre-defined preferences as well as a personal customized preferences.

Art Unit: 2173

Regarding claim 7 and 8, Jen discloses wherein the customized user preference selection is a number, and a limited text entry device (see figures 8-9).

Regarding claim 9, Jen discloses user preference selection along with the customizable selection in the user preference selections includes updating the customizable selection in the user preference selections based upon configuration settings (see col. 5, lines 0051-0054).

Regarding claim 15, Jen discloses wherein the customized user preference selection fields are presented in a drop down list (see col. 4, lines 0058-0059 and figure 5-1).

Regarding claim 16, Jen discloses the user interface means for communicating the customized user preference value to a host computer via a network (see figure 3).

As claims 17-20 are analyzed as previously discussed with respect to claims 1-5 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeza can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cao (Kevin) Nguyen
Primary Examiner
Art Unit 2173

02/14/06